

**REMARKS**

**Summary of the Office Action**

Claims 12-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,340,820 to Youden et al.

**Summary of the Response**

Claims 1-11 and 31-35 are cancelled without prejudice or disclaimer. Accordingly, claims 12-30 are presently pending for consideration. Claims 15 and 18 are amended to improve their form.

**All Claims Comply with 35 U.S.C. § 103(a)**

Claims 12-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 6,340,820 to Youden et al. Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

Applicants respectfully submit that Youden et al. does not teach or suggest an infrared detection medium including a chromophore dye, as recited in independent claims 12, 15, 18, 21, 22, 25 and 28. In contrast, Youden et al. discloses a detection medium including phosphor. The Office Action at page 3 admits that Youden et al. does not disclose a chromophore dye. Nonetheless, the Office Action asserts that it would have been an obvious to one of ordinary skill in the art at the time the invention was made to have used a chromophore dye instead of a

phosphor, since it has been held to be within the general skill of a working in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and then cites *In re Leshin*, 227 F 2d 197, 125 USPQ 416 (CCPA 1960). Applicants respectfully disagree.

As admitted by the Office Action, the applied art of Youden et al. does not disclose a chromophore dye. Applicants respectfully submit that the Office Action fails to identify **any** prior art that teaches or suggests a chromophore dye, nor does the Office Action identify **any** prior art that clearly establishes that the use of a chromophore dye instead of a phosphor in an infrared detection medium is within the level of ordinary skill in the art. MPEP § 2143.03 instructs that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).” Accordingly, because the applied art does not teach or suggest **all** of the features recited in independent claims 12, 15, 18, 21, 22, 25 and 28, Applicants respectfully assert that the Office Action has not established a *prima facie* case of obviousness.

As discussed above, the Office Action at page 3 admits that Youden et al. does not disclose a chromophore dye. However, the Office Action then applies *In re Leshin* in support of the applied 35 U.S.C. § 103(a) rejection. Applicants respectfully traverse such a basis for at least the follow reasons. Moreover, Applicants also respectfully traverse the Office Action’s assertion of “obvious design choice” at page 3. As a result, Applicants request that in the event such an assertion is maintained in the next Office Communication, the Examiner is respectfully requested

to specifically identify a reference in accordance with MPEP § 2144.03 to support the Office Action's assertion that it is obvious to use a chromophore dye instead of a phosphor.

Applicants respectfully submit that there is no recitation in *In re Leshin* supporting the Office Action's assertion of "it has been held to be within the general skill of a working in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice." Further, Applicants respectfully submit that *In re Leshin* has no discussion with regard to "obvious design choice." The holding of *In re Leshin* is with regard to "Mere selection of known plastics to make a container-dispenser of a type made of plastics prior to the invention, the selection of plastics being on basis of suitability for intended use, does not constitute patentable invention." For the Examiner's convenience, a copy of *In re Leshin* is enclosed.

Applicants respectfully assert that *In re Leshin* is inapplicable to the facts associated with the instant application because the prior art of Youden et al. fails to teach or suggest that a chromophore dye is known to make an infrared detection medium of a type made of a chromophore prior to the invention. Further, Youden et al. fails to teach any type of chromophores to make an infrared detection medium. The Office Action admits at page 4 that chromophores are different materials than the phosphors found in the prior art of Youden et al. Thus, the invocation of *In re Leshin* does not cure the deficiency of Youden et al. in failing to teach or suggest a chromophore dye since Youden et al. has no teaching or suggestion to use chromophores.

For these reasons, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection of independent claims 12, 15, 18, 21, 22, 25 and 28 based upon Youden et al. and an interpretation of *In re Leshin* is not a *prima facie* case of obviousness. Further, Applicants respectfully submit that dependent claims 13, 14, 16, 17, 19, 20, 23, 24, 26, 27, 29 and 30 are allowable at least for the reasons discussed above with regard to independent claims 12, 15, 18, 22, 25 and 28 from which these claims depend. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection of claims 12-30 should be withdrawn.

**CONCLUSION**

In view of the foregoing remarks, Applicants request the entry of this Amendment to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Applicants also respectfully request reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims 12-30. Should the Examiner feel that there are any issues outstanding after consideration of this amendment, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted

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